

In re applicati n: Hwang
Filed: 03/28/2001
Response Dated 12/15/2003

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Serial No.: 09/820,072
Attorney's Docket: PAT004US
Reply to Office action of 08/20/2003

REMARKS/ARGUMENTS

Claims 1-15, 35-36, and 39-49 are pending in this application. Claims 1-15, 35-36, and 39-49 have been rejected. Applicant hereby requests further examination and reconsideration of the application in view of the following remarks.

Applicant's undersigned attorney Kinsella would like to thank Examiner Nguyen for his courtesy in a telephone conference with the undersigned on December 15, 2003.

On pages 2-4 of the final Office Action, the Examiner rejected claims 1-15, 35-36, and 39-49 under 35 U.S.C. § 103(a) as being unpatentable over Hwang et al., U.S. Pat. No. 6,406,795, in view of Yu-Hwa Lo (Long Wavelength Vertical Cavity Surface Emitting Lasers).

35 U.S.C. § 103(c) provides:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicant notes that the present Application and the application that matured into the Hwang et al. patent were and are owned by the same entity (namely, Applied Optoelectronics, Inc.). See the face of Hwang et al., field (73), stating "Assignee: **Applied, Optoelectronics, Inc.**, Sugar Land, TX (US)". The present Application was assigned to the same assignee as indicated in the assignment recorded 03/28/2001, Reel/Frame 011684/0489, and included in the file wrapper of this Application.

The Hwang et al. patent issued June 18, 2002. Applicant's application was filed before this date, on March 28, 2001. Accordingly, the Hwang et al. patent is not available as prior art under 35 U.S.C. § 102(b). It is, at most, available as prior art only under 35 U.S.C. § 102(e). Accordingly, pursuant to 35 U.S.C. § 103(c), the Hwang et al. reference **cannot preclude patentability under 35 U.S.C. § 103**. Accordingly, Applicant submits that the § 103 rejection of the pending claims should be withdrawn.

Further, as argued previously, and as apparently accepted by the Examiner, the pending claims are not anticipated under § 102(e) by Hwang et al. In addition, and as apparently implicitly admitted by the Examiner's combination of Hwang et al. and Lo, the pending claims are also not anticipated under § 102(e) by Lo.

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The Assistant Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment which may be associated with this communication to our deposit account 50-1705.

In view of the foregoing remarks, the pending claims are believed to be in condition for allowance. Allowance of the pending claims at an early date is earnestly solicited.

The undersigned may be contacted for any questions.

Respectfully submitted,

Date: December 15, 2003



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